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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,896	09/29/2003	Ronald J. Muir	0153-PA	4817
7590	02/10/2005		EXAMINER	
CROMPTON CORPORATION Benson Road Middlebury, CT 06749			REYES, HECTOR M	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/674,896	MUIR, RONALD J.
	Examiner	Art Unit
	Hector M Reyes	1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 November 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-4 is/are allowed.
- 6) Claim(s) 6,11 and 12 is/are rejected.
- 7) Claim(s) 7-10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Examiner's acknowledgment

Examiner acknowledges Applicant's amendment to the Claims and Remarks dated on November 23, 2004.

Status of The Claims

Claim 5 has been amended. Currently, Claims 1-4, 6-1 and 6-12 are under examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Process described in claim 6 it is said to produce "alkaline earth metal salicylates". However, it is unclear how the alkaline earth salt can be obtained if after preparing the alkyl-substituted salicylic acid as described in the step A, the said acid is further reacted with a previously overbased alkali or a phanate or carboxylate non-containing the required **alkaline earth** anion. How can an alkali metal earth be obtained from a reaction process not requiring an alkali-earth-containing reagent?

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1625

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by van Wijngaarden et al, US patent 48698237 and Campbell, US patent 541792.

Van Wijngaarden discloses the preparation of basic alkaline earth metal salts of a blend of organic acids comprising alkyl salicylic acid salts, see column 1, lines 65-67 and column 2, lines 1-28. The alkaline earth metal salts are preferably magnesium, calcium strontium and barium.

Campbell discloses the preparation of composition comprising alkaline earth metal base of alkyl-substituted salicylic acid, see for instance column 2, lines 10-63 and column 3, lines 12-17. See also Applicant's recognition of the disclosure of Campbell in page 4, lines 19-22, wherein Applicant point out that compositions of overbased alkyl salicylates are known in the prior art:

U.S. Patent No. 5,415,792 discloses overbased alkyl salicylates that are said to be
20 useful additives for lubricating oil compositions. In particular, the compositions impart detergency and dispersancy to the lubricating oil composition as well as provide for an alkalinity reserve.

Notice that claims 11 and 12 are improper product-by-process claims. Thus, process limitations do not impart patentability to a product already anticipated by the prior art.

Claims Objected

Claims 7-10 are objected because the said claims depend on rejected claim 6.

Allowable Subject Matter

No prior art disclosing or suggesting the method disclosed in claims 1-4 found.

The closest art was found in Leone, US patent 5030687. Leone discloses a method for the preparation of a detergent-dispersant additives based on salts of alkaline-earth and alkaline metals for lubricating oils. Leone, however, does not disclose or suggests the particular the steps required in claims 1-4.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hector M. Reyes, whose telephone number is (571) 272-0691. The Examiner can normally be reached Monday through Friday from 9:30 to 5:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor Ms. Cecilia Tsang can be reached at (571) 272-0652.

Hector M. Reyes, PhD JD
AU 1625
USPTO Reg. # P-54846
February 7, 2007

Ms. Cecilia Tsang
Patent Examiner Supervisor


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Supervisory Patent Examiner
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